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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/532,191

04/21/2005

Bernardo Nicolas Sanchez

1081-16

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11/27/2007

GOWAN INTELLECTUAL PROPERTY

1075 NORTH SERVICE ROAD WEST

SUITE 203

OAKVILLE, ON L6M-2G2

CANADA

EXAMINER

WONG, JOSEPH D

ART UNIT

PAPER NUMBER

2168

MAIL DATE

DELIVERY MODE

11/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/532,191

Applicant(s)

SANCHEZ, BERNARDO NICOLAS

Examiner

Joseph D. Wong

Art Unit

2168

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 Nov 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Claims 1-3, 5-7 and 9 are amended. Claims 4, 8 and 10 are canceled. No claims are new.

#### *Response to Arguments*

Objections with respect to the drawings are withdrawn.

Rejections with respect to 35 USC 112, 2<sup>nd</sup> with respect to claims 2-9 are withdrawn.

Rejection with respect to 35 USC 101 rejection of claim 10 is withdrawn.

Arguments against the prior art rejections under 35 USC 102(b) of claims 1-3 and 5-7 are considered yet are deemed not persuasive because they are incorrect because they assert limitations that are not commensurate with the scope of the instantly amended claims.

On Page 7, citations of case law are noted “[*In re Wilder*, 166 USPQ 545,548 (C.C.P.A. 1970)]”, “[*In re Donohue*, 632 F.2d 123,207 USPQ 196 (C.C.P.A. 1980); referred to in *Ex parte Humphreys*, 24 USPQ 2d 1255,1261-62 (B.P.A.I. 1992)]”, “[*Ciba-Geigy Corp. v. Alza Corp.*, 37 USPQ 2d 1337, 1341 n.3 (Fed. Cir. 1995)”. These citations of case law are deemed NOT persuasive for multiple reasons. First, their fact patterns are not shown to be matching thus leaving open the question of whether case laws are even controlling in this specific situation. Second, the quotations appear off point with respect to the original point of anticipation in this case because they appear to allege multiple tangential issues of enablement and public possession without any correlation to a previously applied prior art reference of Sull. Third, there is no change in the outcome of this case because there is no cohesive rationale demonstrating why the quotations should change outcome of this case.

Rejections under 35 USC 102(b) of claims 1-3, 5-7 are amended with modified citations as necessitated by the instant claim amendment.

On Page 9, the arguments assert an argument that “Sull does not provide a method where all documents are stored separately from the original source document”. This argument is moot because the limitation “separately” is not commensurate with instantly amended claim 1.

On Page 10, the arguments assert an argument that “Sull’s record of the URL would not provide the content which is saved and displayed in Applicant’s approach”. This argument is moot because “saved and displayed” is not commensurate with instantly amended claim 5.

On Page 10, the arguments assert an argument that “Sull is not saving a copy of original information but references to specific items”. This argument is moot because the limitations of “references” is not commensurate with instantly amended claim 6.

On Page 11, the arguments against claim 1 assert “if the original database of Sull were removed, would the user be able to access the desired information”. This argument is moot because this alleged hypothetical removal is not commensurate with instant claim 1 because the root phraseology of “remove” is not observed within the claim. The allegation of a difference of being able to retrieve content after deleting the original database file after a removal appears related to the an allegation that the storage is somehow separate as alleged on Page 9 of the instant argument. These arguments are not persuasive because they both are not commensurate with the instantly amended claim 1.

Arguments with respect to prior art rejections of claim 9 under 35 USC 102(b) are considered moot with respect in view of new grounds of rejection under 35 USC 103(a) necessitated by the instant claim amendment.

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Accordingly, all pending claims remain in a rejected state with respect to the prior art.

### ***Claim Objections***

Claims 2-3, 5-7, 9 are objected to under 37 CFR 1.121(c)(2) as having informal use of square brackets which are used to delete 6 characters (above the limit of 5 characters) in claim 5 and for not being formal double square brackets on claims 2-3, 5-7 and 9. For purposes of examination, Applicant's use of the square bracket is interpreted to be an intended deletion as best understood by the Examiner.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-3 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Sull et al., US Pre-Grant Pub. No. 2002/0069218 A1, Filed 23 Jul. 2001, Pub. Date 6 Jun 2002, hereinafter Sull.**

Regarding claim 1, Sull shows a computerized method of information retrieval comprising: providing a computer displayable document having searchable content (interpreted to also include "multimedia file...images that contain text", abstract); marking said document

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(interpreted to include “tag or bookmark”, abstract; Fig. 2), with a marking device (interpreted to include “bookmark”, paragraph [53]; Fig. 2; [0172]), as being a relevant document ([376]); storing said relevant document in a user defined data structure (interpreted to include “bookmarked position”, Fig. 12; [0211]) wherein said user defined data structure comprises a database of stored documents (Fig. 33) which are copied and stored on a storage device (Fig. 18); and conducting a search of a number of said relevant documents using a search engine to identify documents with a desired searchable content ([53]), Fig. 15; [214]); comparing said stored document with an updated copy of said stored document (see ¶[518], Figs. 43-44; Claim 72); selecting, using a selection device (Fig. 2; [0172]), the documents identified as having said desired searchable content ([0051-0053]), and displaying either said original stored copy, or an updated image (interpreted to include “refresh frames”, ¶[301, 313]) of said selected document (interpreted to include “query”, “search”, and “play”, from Fig. 6, 3, 2).

Regarding claim 2, Sull shows a computerized method as claimed wherein a visible document is displayed, and said computerized method is operated by accessing a computerized device selected from the group consisting of stand alone computers, laptop computers, (Fig. 45, item 4524), PDA’s (Fig. 45, item 4522), and an Internet enabled cellular phones (Fig. 45, item 4518). ([35])

Regarding claim 3, Sull shows a computerized method as claimed wherein said document is selected from the group consisting of Internet web pages (Fig. 61), word processor documents

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(interpreted to be optional), spreadsheets (interpreted to include a "matrix", [380]), e-mails ([355, 365]), and a database file ([380]).

Regarding claim 5, Sull shows a computerized method as claimed wherein said document is stored on said storage device (Figs. 18-19) together with a file location and name, or with a URL addresses specific for said document ([172-173, 321]).

Regarding claim 6, Sull shows a computerized method as claimed wherein said document is stored on a storage device selected from the group consisting of said user's computer, local storage device, remote storage device ([328]), network storage device ([411]), Internet storage device ([521]), and Application Service Provider storage device ([290]).

Regarding claim 7, Sull shows a computerized method as claimed wherein said searchable content is selected from the group consisting of text (Fig. 15, items 1516, 1518), highlighted text ([349], [355], [363]), notes ([288]), annotations ([288]), summaries (Table 4, [366]) and attachments ([353]).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sull et al., US Pre-Grant Pub. No. 2002/0069218 A1, Filed 23 Jul. 2001, Pub. Date 6 Jun 2002, hereinafter Sull in view of Prakash. (US Patent 6,931,597 B1), Filed 17 Apr 2002, Patent Date 16 Aug 2005.**

Regarding claim 9, Sull does not explicitly show a computerized method as claimed wherein access to said relevant content is controlled by a permission based authorization system.

However, Prakash, shows a computerized method as claimed wherein access to said relevant content is controlled by a permission based authorization system. (interpreted to include different permission levels for different users within the same document as discussed in Col. 6, Lines 49-56)

Sull and Prakash are analogous art pertinent to the problem to be solved. A skilled artisan would have been motivated to combine Sull and Prakash because it provides for greater ease of file identification as discussed in Prakash, Col. 2, Lines 6-7.

Therefore at the time of invention, it would have been obvious to a person having ordinary skill in the art to combine Sull and Prakash because it provides for greater ease of file identification as suggested in Prakash, Col. 2, Lines 6-7.

### ***Conclusion***

Applicant's amendment necessitated the amended citations (or new ground(s)) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See



MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

If applicant still believes there is patentable subject matter within the disclosure and has reasons why those differences define over the prior art, then applicant can look to MPEP § 324 IV (August 2006) and 37 CFR 1.114 for additional suggestions that may be helpful for overcoming the finality of this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D. Wong whose telephone number is 571-270-1015. The examiner can normally be reached on Mon.-Thur. 8:30AM - 6:00PM and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim T. Vo can be reached on (571) 272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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20 November 2007

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